

REMARKS

1. Applicant thanks the Office for its remarks and observations, which have greatly assisted Applicant in responding. Applicant also particularly thanks the Examiner for generously suggesting an amendment to the independent Claims.

2. **35 U.S.C § 112**

Claims 23-25 are alleged to be indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. More particularly, it is alleged that the last two elements of Claim 23 fail to describe structure "for the search request." To describe the subject matter of the invention more clearly, Claim 23 is amended to describe:

"at least one user terminal;

at least one database containing information about online and offline providers;

said at least one terminal further comprising:

at least one module for searching the database and for providing an integrated list of online and offline providers in response to a search request for a selected item;

at least one module for distinguishing online providers from offline providers in said integrated list; and

at least one module for comparing the online and offline providers for the selected item;

wherein when the search request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored; and

wherein when the request is for a predetermined proximity to a target location, the user may choose a radius for said target location. "

Support for the amendment is found at least at ¶ 0024 of U.S. patent application pub. no. 2003/0074267. As amended, Claim 23 describes that the claimed terminal includes modules for accomplishing the search. Applicant therefore considers the present rejection overcome.

2. **35 U.S.C § 103**

Under *Graham*, establishment of a *prima facie* case of obviousness requires resolution of the following factors:

1. the scope and content of the prior art;
2. the level of ordinary skill in the art;
3. the differences between the claimed invention and the prior art; and
4. objective evidence of nonobviousness.

Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966).

Claims 1, 3 and 6-25 are rejected as being unpatentable over Pricescan in view of U.S. patent application pub. no. 2002/0152134 (“McGlinn”) and further in view of U.S. patent no. 6,594,666 (“Biswas”). Applicant respectfully disagrees. Nevertheless, to describe the Claimed subject matter in greater detail, Applicant further amends Claim 1 to include a step of: “providing comparison information about online and offline providers of selected products and services. . . .” Support for the amendment is found in Claim 6, now cancelled from the Application. Additional support is found at least at ¶ 0018 of U.S. patent application pub. no. 2003/0074267.

While Pricescan lists online and brick-and-mortar merchants in the same list, there is no teaching in Pricescan that online and brick-and-mortar merchants be distinguished from each other in the list. Nor is there any teaching in Pricescan that online and brick-and-mortar merchants be compared with each other. McGlinn also fails to teach the provision of information for online and brick-and-mortar merchants to be compared. As shown in McGlinn’s Fig. 8, McGlinn displays certification information of certified merchants, but there is no teaching or suggestion of displaying comparison information of online and brick-and-mortar merchants. In fact, McGlinn teaches, at least at ¶¶ 0042 and 0059 that online and brick-and-mortar merchants are segregated from each other, thus discouraging comparison between a merchant of one type and one of the second type. There is, therefore, no teaching or suggestion in the combination of providing comparison information about online and offline providers of selected products and services.

Because amended Claim 1 describes suggest matter neither taught nor suggested by the combination, Claim 1 is deemed allowable over the combination. Claims 22 and 23 are amended in similar fashion to Claim 1. Accordingly, Claims 22 and 23 are deemed allowable for the same reason that Claim 1 is allowable. In
5 view of their dependence from an allowable parent claim, the dependent Claims are deemed allowable without any separate consideration of their merits.

No new matter is added by way of the foregoing amendments. Such amendments are made only in the interest of advancing prosecution of the Application, in recognition of the Office policy of compact prosecution. Such do not
10 constitute agreement by Applicant with the Office's position. Nor do they reflect intent to sacrifice claim scope. In fact, Applicant expressly reserves the right to pursue patent protection of a scope it reasonably believes it is entitled to in one or more future submissions to the Office.

For the record, Applicant respectfully traverses any and all factual assertions
15 in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

20 CONCLUSION

In view of the foregoing, the Application is deemed to be in allowable condition. Accordingly, Applicant seeks favorable reconsideration and prompt allowance of the claims. Should the Examiner find it helpful, he is encouraged to
25 contact applicant's attorney at 650-474-8400.

Respectfully submitted,



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